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**UNITED STATES DEPARTMENT OF COMMERCE**  
**United States Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/192,579 11/17/98 MENOZZI

F 960-34

EXAMINER

HM22/0927

NIXON AND VANDEHYDE  
1100 NORTH GLEBE ROAD  
8TH FLOOR  
ARLINGTON VA 22201

SWARTZ, R

ART UNIT

PAPER NUMBER

1645

DATE MAILED:

09/27/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/192,579**

Applicant(s)  
**Menozzi et al**

Examiner  
**Rodney P. Swartz, Ph.D.**

Art Unit  
**1645**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on 8February1999, 29January2001.

2a) ☐ This action is **FINAL**.

2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 30-35 and 56-81 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☒ Claims 30-35 and 56-81 are subject to restriction and/or election requirement.

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.

12) ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☒ All b) ☐ Some\* c) ☐ None of:

1. ☒ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

20) ☒ Other: copy of Oath/Declaration

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### **DETAILED ACTION**

1. Applicants' Preliminary Amendment is acknowledged. Claim 1-29 have been canceled without prejudice.

New Claims 30-55 have been added. However, new claims 30-55 are objected to under 37 CFR §1.52(a) and (d), requiring that any amendments must be in the English except when accompanied with an English translation, a statement that the translation is accurate, and the appropriate fees.

2. Applicants' Second Preliminary Amendment, received 8February1999, paper#9, is acknowledged. Claims 36-55 have been canceled without prejudice. New Claims 56-81 have been added.

3. Applicants' Response to Notice to Comply, received 29January2001, paper#15, is acknowledged. The sequence listing has been entered.

4. Claims 30-35 and 56-81 are pending.

### **Oath/Declaration**

5. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because the facsimile copy of contains many indistinct and missing sections (see attached copy).

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**Priority**

6. Acknowledgment is made of applicant's claim for foreign priority based on application 96/06168 filed in France on 17May1996. It is noted, however, that applicant has not filed a certified English translation of the application as delineated in 35 U.S.C. 119(b). Until a certified English translation of the application is submitted, the priority date is that of the instant application.

**Election/Restriction**

7. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 30-35, 56-70, drawn to polypeptides, classified in class 424, subclass 248.1.
  - II. Claims 71-78, drawn to DNA, vector, host cell, classified in class 536, subclass 23.7.
  - III. Claim 79, drawn to use of polypeptide to make a drug, classified in class 424, subclass 181.1.
  - IV. Claims 80-81, drawn to method of inhibiting mycobacterial adhesion, classified in class 424, subclass 9.2.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are drawn to structurally and functionally distinct molecules, Invention I is drawn to amino acids and Invention II is drawn to nucleic acids.

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Inventions I and III-IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the polypeptides of Invention I can be used to immunize a host against infection with mycobacteria.

Inventions II and III-IV are drawn to structurally and functionally distinct molecules, Invention II is drawn to nucleic acids and Inventions III-IV are drawn to amino acids.

Inventions III and IV are drawn to patentably distinct methods using different reagents and having different outcomes.

Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification, and because while the searches may overlap, the searches are not coextensive, restriction for examination purposes as indicated is proper.

8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

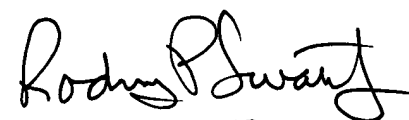
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application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney P. Swartz, Ph.D., whose telephone number is (703) 308-4244. The examiner can normally be reached on Monday through Friday from 6:30 AM to 4:00 PM EST.

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Lynette F. Smith, can be reached on (703)308-3909. The facsimile telephone number for the Art Unit Group is (703)308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703)308-0196.



RODNEY P. SWARTZ, PH.D.  
PRIMARY EXAMINER  
Art Unit 1645

September 27, 2001

